

REMARKS

1. Based on the Office communication, the applicants have further amended the claim 1.

This application mainly apply the adhering and larger in size characteristics of the MSCs. Therefore, the MSCs can be separated and adhered on the upper plate. The other smaller-sized cells can pass through the pores. The cells that are collected on the lower plate are not the point of this method, no matter whether they are hematopoietic cells or not. Furthermore, the other small-sized non-adhering cells can migrate and pass through the pores of the upper plate due to the gravity.

The step (d) is also added in claim 1.

The application uses the adhering and larger in size characteristics of the MSCs, which increases the isolating and culturing efficiency of the MSCs.

2. The pore size of the upper plate in claim 1 is limited to the range of 0.4 to 40 microns, but not in any size.
3. Based on the teaching of prior arts, one with ordinary skill in the art can use an upper plate with pore size of 0.4 to 40 microns to separate MSCs with other smaller size cells. Therefore, there was no undue experiment works needed.
4. A new claim with smaller range of pore size is also added in this amendment, which is within the original range of 0.4 to 40 microns. The newly added limitation to claim 1 by narrowing the pore size is, of course, within the original range, 04 to 40 microns. In other words, the new limitation is within the original scope, which shall not constitute a new matter.

As your MPEP stated in 2163.06 Relationship of Written Description Requirement to New Matter, "information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter."

In *Heymes v. Takaya*, 6 U.S.P.Q.2d 1448 (Bd. Pat. App. & Int. 1988), *aff'd*, 10 U.S.P.Q.2d 1473 (Fed. Cir. 1989), the Board noted that it is not necessary that the

claimed subject matter be described in *ipsis verbis* to satisfy the written description requirement of 35 U.S.C. §112. Accordingly, in view of the *Heymes* holding, the written description requirement does not require a description of subject matter in "*ipsis verbis*," nor does it require a specific example. *Id.* at 1452.

In *re Wertheim*, 541 F.2d at 263, 191 U.S.P.Q. at 97, the CCPA made it clear that "[b]roadly articulated rules are particularly inappropriate" in applying the description requirement to narrowed claims involving ranges. In the case, the CCPA held that the PTO failed to establish a *prima facie* case of noncompliance with the description requirement even though there was lack of literal support. The PTO presented no evidence that one skilled in the art would not view the narrower range as within *Wertheim's* invention

Furthermore, one of the most famous examples is the case of *Hilton Davis Chemical Co. v. Waner-Jenkinson Company, Inc.*, in which the range of the pH value was also narrowed. Neither the judges of Supreme Court nor the judges of CAFC (*en banc*) mentioned the "new matter" issue. Therefore, the new limitation within the original scope shall not constitute a new matter.

Accordingly, this application should be placed in condition of allowance. An early Notice to this effect is respectfully expected.

Respectfully submitted:

By: 

Shih-Chieh Hung

886-2-28757557 ext 118 (voice)

886-2-28265164 (fax)

hungsc@vghtpe.gov.tw(email)

No 201 Shih-Pai Rd Section II,

Taipei-Veterans General Hospital, Taipei,

Taiwan, R. O. C.